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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,998	03/12/2001	Hirohisa Naito	826.1698	6400

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EXAMINER

BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,998

Applicant(s)

NAITO ET AL.

Examiner

Andre Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 16-20 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 16-20 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/4/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 1, 2, 8-15, 21-28, and 34-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 22, 2005. Claims 1, 2, 8-15, 21-28, and 34-40 have been canceled.
2. Claims 3-7, 16-20, and 29-33 have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical

sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case the independent claims 16-20 only recite an abstract idea. The recited steps of obtaining data, recording and storing data, analyzing recorded and stored data, etc. does not involve, use, or advance the technological arts (i.e., computer, processor, electronically, etc.), since the steps could be performed using pencil and paper.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed invention isolates a cause of the problem, thereby producing a useful, concrete, and tangible result, but not within the technological arts as explained above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-7, 16-20, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady et al (US 2002/0062244), in view of Fowler et al (US 2002/0026348).

As per claim 3, Brady et al disclose behavior data fee collection system using computer (central server 22 billing and collecting payments, ¶ 0038), comprising: data process unit (i.e., location manager 172, ¶ 0047) processing data in which a paired series of at least place information (i.e., define the location participating in the campaign, ¶ 0047) and information about the place (i.e., capabilities of the location, ¶ 0047), provided to a user are described according to a prescribed specification (i.e., limits on what kinds of campaigns will be hosted at the location, ¶ 0047). Brady et al does not explicitly disclose fee collection unit collecting a fee from a facility included in the place information described in the data. Fowler et al disclose the merchant (i.e., facility/location) paying a participating fee to the market program administrator (¶ 0042). Both Brady et al and Fowler et al are concerned with effective target marketing, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include collecting a fee from a facility included in the place information in Brady et al, as seen in Fowler et al, as an effective means of providing a revenue model for the marketing program (see Fowler et al, ¶ 0042).

As per claim 4, Brady et al disclose behavior data fee collection system using a computer (central server 22 billing and collecting payments, ¶ 0038), comprising:

data process unit (i.e., location manager 172, ¶ 0047) processing data in which a paired series of at least place information (i.e., define the location participating in the campaign, ¶ 0047) and information about the place (i.e., capabilities of the location, ¶ 0047), provided to a user are described according to a prescribed specification (i.e., limits on what kinds of campaigns will be hosted at the location, ¶ 0047); a place data acquisition unit obtaining place data transmitted from the unit (i.e., location server 16, ¶ 0038); and a behavior data generation unit totaling information from obtained place data as behavior data (i.e., central sever 22 collecting customer data and location data and analyzing the data to extract information concerning buying habits and thinking characteristics, ¶ 0041). Brady et al does not explicitly disclose a behavior data fee calculation unit calculating a fee of the behavior data. Fowler et al disclose the merchant (i.e., facility/location) paying a participating fee to the market program administrator, wherein the fee may be flat per transaction or accrue as a percentage of transaction value (¶ 0042). Both Brady et al and Fowler et al are concerned with effective target marketing, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include calculating a fee of the behavior data in Brady et al, as seen in Fowler et al, as an effective means of providing a revenue model for the marketing program (see Fowler et al, ¶ 0042).

As per claim 5, Brady et al disclose behavior data fee collection system using computer (central server 22 billing and collecting payments, ¶ 0038), comprising: facility data registration unit registering facility data (i.e., location manager 172, ¶

0047); and a behavior data generation unit (i.e., location manager 172, ¶ 0047) generating data in which a paired series of at least place information (i.e., define the location participating in the campaign, ¶ 0047) and information about the place (i.e., capabilities of the location, ¶ 0047), provided to a user are described according to a prescribed specification (i.e., limits on what kinds of campaigns will be hosted at the location, ¶ 0047). Brady et al does not explicitly disclose a registration fee calculation unit calculating a registration fee when the data are registered. Fowler et al disclose the merchant (i.e., facility/location) paying a participating fee to the market program administrator (¶ 0042). Both Brady et al and Fowler et al are concerned with effective target marketing, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include calculating a registration fee when the data are registered in Brady et al, as seen in Fowler et al, as an effective means of providing a revenue model for the marketing program (see Fowler et al, ¶ 0042).

As per claim 6, Brady et al disclose a behavior data fee collection system using a computer (central server 22 billing and collecting payments, ¶ 0038), comprising: a facility data registration unit registering facility data (i.e., location manager 172, defining participating locations ¶ 0047); a behavior data generation unit (i.e., location manager 172, ¶ 0047) generating data in which a paired series of at least place information (i.e., define the location participating in the campaign, ¶ 0047) and information about the place (i.e., capabilities of the location, ¶ 0047), provided to a user are described according to a prescribed specification (i.e., limits on what kinds

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of campaigns will be hosted at the location, ¶ 0047); and a behavior data process unit obtaining information about use of data when the data is generated (i.e., central sever 22 collecting customer data and location data and analyzing the data to extract information concerning buying habits and thinking characteristics, ¶ 0041). Brady et al does not explicitly disclose charging a fee against each facility at the time. Fowler et al disclose the merchant (i.e., facility/location) paying a participating fee to the market program administrator (¶ 0042). Both Brady et al and Fowler et al are concerned with effective target marketing, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include charging a fee against each facility in Brady et al, as seen in Fowler et al, as an effective means of providing a revenue model for the marketing program (see Fowler et al, ¶ 0042).

As per claim 7, Brady et al disclose a behavior data fee collection system using a computer (central server 22 billing and collecting payments, ¶ 0038), comprising: a facility data registration unit registering facility data (i.e., location manager 172, defining participating locations ¶ 0047); a behavior data generation unit (i.e., location manager 172, ¶ 0047) generating data in which a paired series of at least place information (i.e., define the location participating in the campaign, ¶ 0047) and information about the place (i.e., capabilities of the location, ¶ 0047), provided to a user are described according to a prescribed specification (i.e., limits on what kinds of campaigns will be hosted at the location, ¶ 0047); a behavior data process unit (i.e., central server 22, ¶ 0041) obtaining information about use of data when the

data are downloaded (i.e., collection of location data, ¶ 0041), when use of the data is started, when each facility is reported in a process of the data or when guidance or advertisement on each facility is presented to a user in a process of the data (i.e., defining the capabilities of the locations, what campaigns the locations will participate in, and the limits on what kind of campaigns will be hosted at each location, ¶ 0047). Brady et al does not explicitly disclose charging a fee against each facility at the time. Fowler et al disclose the merchant (i.e., facility/location) paying a participating fee to the market program administrator (¶ 0042). Both Brady et al and Fowler et al are concerned with effective target marketing, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include charging a fee against each facility in Brady et al, as seen in Fowler et al, as an effective means of providing a revenue model for the marketing program (see Fowler et al, ¶ 0042).

Claims 16-20 are rejected based upon the rejection of claims 3-7, respectively, since they are the method claims, corresponding to the system claims.

Claims 29-33 are rejected based upon the rejection of claims 3-7, respectively, since they are the storage medium claims, corresponding to the system claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Herz et al (USPN 6571279) disclose customizing information displayed to a recipient.

-Busche et al (US 2003/0055707) disclose ascertaining the favorable positioning of products in a retail environment.

-O'Brien et al (US 6321210) disclose distributing coupons or certificates in a retail store.

-Seigel et al (US 2001/0051876) disclose selecting content by categorizing attributes of a user.


-Fano (USPN 6317718) disclose an information gathering agent.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


adb
July 10, 2005


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